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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,156	01/22/2002	Jorge Abel Groiso	NIE-0003-US	7921
28970	7590	11/03/2003	EXAMINER	
SHAW PITTMAN			PRIDDY, MICHAEL B	
IP GROUP			ART UNIT	
1650 TYSONS BOULEVARD			PAPER NUMBER	
SUITE 1300			3732	
MCLEAN, VA 22102			DATE MAILED: 11/03/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/051,156	GROISO, JORGE ABEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael B Priddy	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 7-10 andz 14-16 is/are rejected.
- 7) Claim(s) 4-6, 11-13 and 17-21 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of species V in Paper No. 5 is acknowledged. The traversal is on the ground(s) that all claims, 1-21, are readable on the elected species and therefore a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of the non-elected claims. After considering this argument and reviewing the Figures and the claims it is the Examiner's belief that claim 9, which reads on the embodiment of Fig. 12, cannot be readable on the embodiment of Fig. 11. However, the search for the features of the embodiment of Fig. 11 is largely coextensive with the search for the embodiment of Fig. 12 and did not appear to be burdensome enough to withdraw claim 9 from consideration. In conclusion, an action on the merits of claims 1-21 follows.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because in line 10 the period after "preferably" should be deleted and in line 11, Applicant has used "means". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jobe (U.S. 5,787,713). Jobe teaches a bone staple 70 capable of correcting bone deficiencies by controlling the growth of the epiphyseal plate, the staple comprising: a shape memory material body comprising a cross bar 74 and at least two legs 72 extending from the cross bar. The cross bar 74 is resiliently deformable between an initial orientation and an insertion orientation upon application of a force to the cross bar 74. The legs 72 are oriented at an angle relative to the opposite leg 72 when the body

portion is in the initial orientation and the legs 72 are substantially parallel when the body portion is moved to the insertion orientation for insertion of the legs 72 into tissue. The leg portions at least partially return to the initial orientation when the force applied to the cross bar 74 is released such that the legs 72 anchor the staple 70 to the tissue. As shown in Fig. 16, the legs may be "initially directed outwardly" such that they diverge. Concerning the language of claim 2, the embodiment of Fig. 16 clearly shows each leg at an angle of greater than 90° relative to the cross bar 74. Furthermore, cross bar 74 extends beyond a corner joint between the cross bar 74 and the legs 72 forming a curved shoulder means (Exhibit A) for abutting the bone and the cross bar defines an arc shape.

Concerning the limitations of claim 9, the embodiment of Fig. 17 shows a staple 70 having reinforcing means 78 at each corner joint between the legs 72 and the cross bar 74.

Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Oberlander (U.S. 6,554,852). Oberlander teaches a bone staple comprising: a body comprising a cross bar 31 and at least two legs 21 extending from the cross bar 31, wherein each leg includes an helical thread designed for anchoring into the bone, the cross bar 31 being capable of being cut; the helical thread defining a screw in each leg 21 of the staple.

***Claim Rejections - 35 USC § 103***

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jobe.

Jobe discloses the claimed invention except for the staple body being made of nitinol. It would have been obvious to one having ordinary skill in the art at the time the invention was made construct the staple body of nitinol since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander in view of Archuleta et al. (U.S. 5,425,407). Oberlander, as presented in the above rejections under 35 U.S.C. 102(b), teaches all of the limitations of the present invention except the helical thread is defined by a longitudinal cross section comprising an upper flat plane and a lower inclined plane, both planes helically extending around the corresponding leg. Archuleta et al. teaches a screw 50 having a buttress thread 22. As described in lines 35-40 of column 2, a buttress thread has an upper pressure face or flank which is substantially perpendicular to the central axis while the lower, or buttress face or flank, has a generally plane surface whose cross-section is about 25 to 55 degrees from the axial direction. This type of thread design results in less resistance to insertion and greater resistance to forcible ejection. It would have been obvious to one of ordinary skill in the art at the time of the present invention to form the thread of Oberlander as a buttress thread so as to allow for easy installation of legs 21 while decreasing probability of ejection.

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***Allowable Subject Matter***

Claims 4-6, 11-13 and 17-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

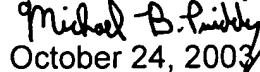
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

  
Michael B. Priddy

October 24, 2003